REMARKS

STATUS OF THE CLAIMS

In accordance with the foregoing, claims 1 and 56 have been amended. Claims 1-63 are pending and under consideration.

No new matter is being presented, and approval of the amended claims is respectfully requested.

REJECTIONS OF CLAIMS 1-63 FOR OBVIOUSNESS UNDER 35 USC §103(a) AS BEING UNPATENTABLE OVER HSU ET AL. (U.S. PATENT NO. 6,377,956 B1) IN VIEW OF WORLD WIDE WEB CONSORTIUM, *XML SCHEMA PART I: STRUCTURES*, W3C WORKING DRAFT (MAY 6, 1999)

The rejections of claims 1-63 are respectfully traversed and reconsideration is requested.

Claims 1 and 56, as amended herein, are directed to a hub document preparation method and apparatus, respectively, for use in a computer system having a file system to manage data by storing the data in a file-system directory.

On the other hand, Hsu et al. (hereinafter "Hsu") merely discloses a system for storing data (for example, component documents, component media and media) for assembling product manuals based on a product model. However, the data is stored in a database other than a computer system.

Moreover, in the Response to Arguments on page 10 of the final Office Action mailed April 27, 2005, the Examiner refers to Sato et al. (hereinafter "Sato") in supporting the rejection of claim 1. The Examiner states, "Sato teaches converting a non-structured document into a structured document. Sato also teaches storing generated structured document[s] in the structured document repository," citing column 6, line 66 to column 7, line 35 and Fig. 18.

However, the cited portions of Sato provide no discussion of storing, *each time one of the plurality of non-structured documents to be included in the hub document format structured document is prepared or edited*, the non-structured document into the original document file-system directory, as recited in claim 1, for example (emphasis added).

Therefore, the rejection must be withdrawn because the Examiner has relied on personal knowledge, and has not provided adequate evidence in support of the obviousness rejection.

According to MPEP 2143.03, "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (emphasis added). MPEP 2106 states that, "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation."

Claim 1 recites, in relevant part:

> *automatically* adding the entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory *by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations referring to the structured documents.* (emphasis added)

It is respectfully submitted that the Examiner has provided no references teaching "automatically adding the entity declarations to the hub document ... by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations," as recited in claim 1, for example.

It is further submitted that *XML Schema Part I* provides no guidance on how or when entity declarations can be added. Thus, it is respectfully submitted that the Examiner's unsupported assertions do not meet the recited features of claim 1. The Examiner's personal knowledge teaching is only: "basing a hub document on entity declarations regarding the structured documents".

However, this overlooks what claim 1 actually recites. Claim 1 recites <u>when</u> the entity declarations are obtained (responsive to presence of documents in a directory), and in connection, <u>how</u> the entity declarations are obtained (acquiring document names of documents stored in a directory). The rejection addresses only the static structure and content of a hub document. The rejection does not address the particular mechanism for building a hub document that is recited in claim 1, for example.

Finally, the Examiner still has not directly addressed claim 63. Applicant notes that not all of the features of claim 63 have been examined. The rejection grouped claims 1, 49, 56, and 63 but only addressed the features of claim 1. As stated in MPEP 707.07(d), "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group."

The rejection of claim 1, however, cannot be equally applicable to claim 63 because claim

63 recites features not found in claim 1. Claim 63 recites "when preparing the hub document, automatically responding to the presence of the unstructured document files in the pre-determined directory by converting the unstructured document files to corresponding structured document files, where structure of the structured documents is given by markup tags included therein". The rejection does not address this feature and it is not taught or suggested by the prior art.

Claim 63 also recites "automatically acquiring a list of filenames of the respective structured document files in the pre-determined file-system directory, preparing corresponding entity declarations, and adding same to the hub document". The rejection does not address this feature.

Claim 63 further recites that "but-for the presence of the structured documents in the pre-determined file-system directory they would not be referenced in the hub document and where the presence of the structured documents in the pre-determined file-system is what determines that they are to be referenced in the document directory". The Examiner has not addressed this feature, which is not found in claim 1.

Therefore, the current rejection of claim 1 is not equally applicable to claim 63. Thus, the rejection is further traversed for failure to establish a *prima facie* case of obviousness with respect to claim 63.

Accordingly, the rejections of independent claims 1, 56 and 63 are respectfully traversed. Dependent claims 2-55 depend from claim 1, and claims 57-62 depend from claim 56. Dependent claims 2-55 and 57-62 inherit the recitations of their respective base claim and, thus, it is respectfully submitted that claims 2-55 and 57-62 also patentably distinguish over the prior art.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: ~~September 27, 2005~~   By: ~~David M. Pitcher~~

David M. Pitcher
Registration No. 25,908

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501